



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,968	03/22/2000	Jacques Jolly	Q58469	8709

23373 7590 06/05/2002

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 06/05/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

24-9

Advisory Action

Application No.

09/532,968

Applicant(s)

JOLLY ET AL.

Examiner

John Hoffmann

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

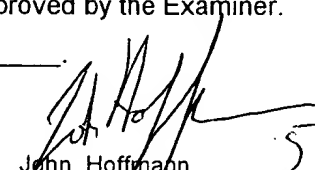
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-8

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


John Hoffmann
Primary Examiner
Art Unit: 1731

5-314

Continuation of 5. does NOT place the application in condition for allowance because: the two inventions do not require the same steps or searches. Although applicant argues that the searches are the same, no evidence or rationale is given to support this. The invention of claims 1-8 requires class/subclass 65/433 to be searched and does not require 65/421 to be searched. Whereas the invention of claims 9-17 requires 65/421 but not 65/433. Whereas original claim 1 uses language such as "leads to a new layer of material being deposited" a complete reading of the claim shows that such limitations are not steps that are claimed, rather they are directed to limiting the apparatus in which the method is carried out. (see the rejection). AS to the mutually exclusive species arguments, the conclusion that they are not mutually exclusive is not understood nor is any rationale given to explain how the two conditions can be met by the same process - clearly the layers are progressively smaller, or they are all the same length (i.e. extend between the same planes). The rest of the arguments are directed to Examiner's "construction" of the claims. All of the claims were constructed by Applicant, none by the Office. Whereas the Office is to interpret claims in light of the specification; this does not mean inserting limitations from the specification into the claims. It is argued that the reduction in length is not cutting the layer. The Office understands a layer length can be reduced by other steps such as shrinkage and abrading, and that the reduction is not limited to cutting, the Office used the term "cutting" because that is how the prior reduced the length of layers. Although the specification indicates that the reduction occurs by shortening the pass of a subsequent layer, there is no reason to believe that the subsequent layer is the old layer which is now shortened. ON the contrar, that shorter layer is a completely new layer with a new length. Most importantly, whereas Applicant holds that the claims have been misconstrued with what is disclosed in the specification - the specification cannot redefine terms such that claims should now take on means completely inconsistent with normal English usage. A reduction in the length of a layer clearly means to have a layer (with a length) and then reduce the length. It is completley unfair for the Office to allow claims based on English usage that is repugnant to the way that those of ordinary skill in the art uses English.